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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,419	05/19/2005	Yoshiki Shirakawa	Q87995	5977
23373	7590	07/26/2007	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			MESH, GENNADIY	
		ART UNIT		PAPER NUMBER
		1711		
		MAIL DATE	DELIVERY MODE	
		07/26/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/535,419	SHIRAKAWA ET AL.
	Examiner Gennadiy Mesh	Art Unit 1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 June 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Amendment***

Applicant Amendment filed on June 26,2007 is acknowledged.

Claims 1-12 are pending in Application. Terminal Disclaimer filed by Applicant on June 26,2007 was approved.

Rejection is maintained, but altered due to amendment of claims made by Applicant.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention : language of Claim 1 has reference to "reaction product (2)" – see line 6 . Note that subject matter related to **reaction product (2) was deleted by Applicant.**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. Claims 1- 6 are rejected under 35 U.S.C. 102(a) as anticipated by Yamamoto et al.( JP 2003-119619).

Yamamoto "619" discloses multifilament fiber yarn comprising polyethylene terephthalate produced in the presence of identical catalyst system ( see abstract, claims 1-3) as it claimed by applicant in Claim 1and 2.

Regarding Claims 3 - 5 see Yamamoto "619" [0003], page 1.

Regarding Claim 6 see Table on page 12.

2. Claims 1-6 are rejected under 35 U.S.C. 102(a) as anticipated by Minobe et al.( WO 03/027166) - note that US 7,189,797 used as translation of WO 03/027166.

Minobe discloses process for producing polyester suitable for several applications, including fibers ( see claims 20 and 21 and lines 53-64,column 6), wherein catalytical system and polymer composition are substantially same as claimed by Applicant ( see claims 1 – 8).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action: The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al.( JP 2003-119619) as applied to claims 1-6 above, and further in view of Cho et al.( US 2003/0059612).

Yamamoto polyester fiber yarn, but silent about use of this polyester for fiber knitted or woven fabric application.

However, polyester fibers and use of polyester fibers for knitted, woven or non-woven fabric is known in the art.

Cho discloses use of polyester fibers as multifilament yarn with same Dtex(denier) and Silk Factor as claimed by Applicant ( see Table 1). Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention to use polyester fiber yarn obtain by process of Yamamoto for fabric related application as tire cord as taught by Cho with reasonable expectation of success.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-5 and 7-11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 7,087,299. Although the conflicting claims are not identical, they are not patentably distinct from each other, because they represent obvious variation of each other: Konishi discloses process for producing polyester fibers ( see claims 1- 6 ) by same catalytic system including same Titanium compound and same Phosphorous compound ( see claim 1 ).

5. Claims 1- 6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 and 20-21 of U.S. Patent No. 7,189,797. Although the conflicting claims are not identical, they are not patentably distinct from each other, because they represent obvious variation of each other as it explained above – see paragraph 4.

6. Claims 1- 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/542,373: claims of both Applications significantly overlapping in scope as claimed subject matter drawn to polyester fibers, obtain by the same polymerization process with same catalytic system in both Applications.

This is a provisional obviousness-type double patenting rejection.

7. Claims 1- 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1- 15 of copending Application No. 10/535,419: claims of both Applications significantly overlapping in scope as claimed subject matter drawn to polyester fibers, obtain by the same polymerization process with same catalytic system in both Applications.

This is a provisional obviousness-type double patenting rejection.

#### ***Response to Arguments***

Applicant's arguments with respect to claim 1-12 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

**THIS ACTION IS NOT MADE FINAL.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gennadiy Mesh whose telephone number is (571) 272 2901. The examiner can normally be reached on 10 a.m - 6 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gennadiy Mesh  
Examiner  
Art Unit 1711

GM

  
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